

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Hubertus Johannes Marie OP DEN CAMP, *et al.*

Serial No.: 10/500,872

Based on Int'l App. PCT/NL03/00049

Filing Date: July 7, 2004

For: FERMENTATION OF PENTOSE SUGARS

Examiner: *unassigned*

Art Unit: *unassigned*

Prior Atty Dkt No: 31970-205017

New Atty Dkt No: 28902.0008

New Customer No. 30827

Confirmation No. 1317

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO CORRECT INVENTORSHIP UNDER 37 CFR 1.48(a)

12/09/2004 LLENDGRA 00000042 10500872

02 FC:1464

130.00 DP

The following sets forth the facts concerning inventorship in the above-captioned application.

1. An inventors' Declaration filed in the present application (which is the national phase of PCT/NL03/00049) named the following four inventors: (1) H.J.M. OP DEN CAMP; (2) H.R. HARHANGI; (3) C. VAN DER DRIFT; and (4) J.T. PRONK. The PCT Application, however, only named inventors (1)-(3) and did not name J.T. Pronk.

2. The omission of J.T. Pronk was due to an inadvertent error, without deceptive intent as is explained below.

3. The first 3 named inventors who invented the claimed xylose isomerase gene were all at Nijmegen University. During the preparation of the priority application, rights to this gene were bought by the PCT Applicant, Royal Nedalco B.V. ("Nedalco") from the University of Nijmegen. Thus, all attention was focused on these three University of Nijmegen inventors.

4. As described to the undersigned by Nedalco's Dutch patent attorney, Dr. Bart Swinkels of the Nederlandsch Octrooibureau, Dr. Pronk's name and his contribution were not specifically communicated in correspondence and other contact between the research manager at Nedalco, Dr. Wim de Laat, and Dr. Swinkels. Dr. Swinkels, in turn, did not evoke from Dr. de Laat

further information as to who invented all of the claimed subject matter. When Dr. Swinkels began to draft the priority application which was later filed as the PCT application from which the instant U.S. case claims priority, he knew of only the three originally named inventors. As the invention and application preparation process progressed, Dr. Swinkels and his client did not update their discussion of inventorship and thereby never got around to discussing Pronk's specific contribution on which basis he should have originally been named as a co-inventor.

5. As explained to the undersigned, Dr. Pronk was responsible for inventing the expression of the xylose isomerase gene in yeast. As a result of his contribution to the expression of the claimed xylose isomerase gene in heterologous eukaryotic host cells such as yeast, and the production of ethanol from xylose by such modified host cells, Pronk's contribution was considered by all involved, including the undersigned, to be inventive. His exclusion from the original priority and PCT applications was an inadvertent oversight.

6. Dr. Pronk is a professor of Industrial Microbiology at the Technical University of Delft in the Netherlands and serves as an advisor to Bird Engineering, a research and consultancy company that has a consultancy agreement with Nedalco. Through that agreement, Dr. Pronk indirectly advises Nedalco on ethanol production. It is through this relationship that Dr. Pronk made his inventive contribution to the project that resulted in the present application. As noted, above, Pronk's contribution was simply overlooked during the application process. Only when the PCT application was published did the applicant, Nedalco, and the three named co-inventors first notice the mistaken omission of Pronk's name from the list of inventors.

7. Applicants hereby petition the Commissioner to amend inventorship by adding Dr. Jacobus Thomas Pronk, and accepting the already filed Declaration executed by all four of the co-inventors listed in Section 1, above, including Dr. Pronk.

Dated: 06 December 2004

Respectfully submitted,

By 

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